Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number Q75250	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 10/653,929	Filed September 4, 2003
	First Named Inventor Chun-Hee SONG	
	Art Unit 3628	Examiner Daniel VETTER

WASHINGTON OFFICE
23373
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

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January 14, 2008
Date

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Chun-Hee SONG

Appln. No.: 10/653,929

Confirmation No.: 4912

Filed: September 4, 2003

Docket No: Q75250

Group Art Unit: 3628

Examiner: Daniel VETTER

For: METHOD AND APPARATUS FOR PREVENTING DUPLICATE RECORDING OF A BROADCASTING PROGRAM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated September 12, 2007, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue. As of the Advisory Action mailed December 20, 2007, claims 1-3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. (U.S. Publication 2001/0033736) (reference A of the PTO-892 part of paper no. 20070322) in view of Agnihotri et al. (U.S. Publication 2002/0081090) (reference B of the PTO-892 part of paper no. 20070322).

Applicant respectfully submits that neither Yap nor Agnihotri discloses "extracting additional information from a digital broadcasting program and recording the additional information separately," as recited in claim 1. Yap discloses that an electronic program guide

(EPG) containing program tag information may be searched by a user, and upon selection of a program to record, tag information of previously stored programs are compared to the tag information of the selected program to determine if the program has been previously recorded. See paragraphs [0131]-[0133] of Yap. Thus, the tag information is not *extracted* from the program itself, but is provided by an outside source (the EPG). Agnihotri, on the other hand, discloses that transcripts for programs are obtained from a number of different sources of text, not extracted from the program itself. See abstract of Agnihotri. Thus, neither reference discloses "extracting additional information from a digital broadcasting program" as recited in claim 1.

The Examiner argues:

> Yap teaches multiple recording units and recording the same information as the claimed invention. The only difference between the claimed invention and the applied references is that Yap records the information together and the claimed invention records it separately. A person of ordinary skill in the art would recognize that it would be a routine engineering choice to record information separately for a number of reasons such as accommodating memory capacity, and this modification could have been readily made to obtain predictable results. It is not patentable to use a known technique to improve a method otherwise disclosed in the prior art KSR v. Teleflex, 550 U.S. ___, 82 USPQ2d 1385 (Apr. 30, 2007).
>
> Examiner respectfully submits that Yap is sufficient to teach the "extracting" step, as the claimed embodiments do not limit how or where the extracting occurs (such as extracting the information locally at each recording unit), and therefore read upon the "extracting" as disclosed in Yap.[1]

[1] *See* Advisory Action dated December 20, 2007, page 2.

In the above comments, the Examiner still fails to indicate where Yap discloses *extracting* additional information from a digital broadcasting program. Rather, as noted on page 4 of the Response filed December 12, 2007, Yap discloses that the additional information is provided by an outside source (an electronic program guide (EPG)). The Examiner seems to argue that an extraction of additional information occurs at some time such that the information provided by the EPG is taken from the digital broadcasting program. However, Yap does not indicate that *any* extraction takes place. Yap does discloses *at best* that additional information may be sent along with a digital broadcasting program, but fails to disclose that the additional information is actually *extracted* from the digital broadcasting program. Therefore, Yap can at best only be read as being ambiguous with regard to extraction of additional information. However, ambiguities in the cited art must be construed against the Examiner.[2]

As noted above, Agnihotri, fails to disclose extracting additional information from the digital broadcasting program, as Agnihotri discloses that transcripts for programs are obtained from a number of different sources of text, not extracted from the program itself. See abstract of Agnihotri.

Therefore, the applied art, taken individually or in combination, discloses the extracting operation recited in claim 1.

With regard to the Examiner's citation to *KSR*, the citation fails to apply to a situation in which one of the elements of the claims is not disclosed, as in this application. Contrary to the Examiner's statement "[t]he only difference between the claimed invention and the applied

[2] *See In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

references is that Yap records the information together and the claimed invention records it separately,"[3] Yap fails to disclose the extracting step, as noted above. Thus, the Examiner's citation to *KSR* is misplaced, as the differences in the instant application and Yap are more than simply the recording of additional information.

Conclusion

For the above reasons, claim 1 is not rendered obvious in light of the Examiner's proposed combination of Yap and Agnihotri and is patentable over the applied art. Claim 9 recites similar limitations to claim 1, and is patentable for analogous reasons thereto. Claims 2 and 3 are patentable at least by virtue of their dependency from claim 1.

Claim 10 is patentable at least by virtue of its dependency from claim 9, as Kanemitsu fails to cure the defects noted in the proposed combination.

Respectfully submitted,

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[3] *See* Advisory Action dated December 20, 2007, page 2.